UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/691,409	10/18/2000	Jaime A Siegel	SNY-N3422	3951

24337 7590 07/09/2003

MILLER PATENT SERVICES
2500 DOCKERY LANE
RALEIGH, NC 27606

EXAMINER
KIM, AHSHIK

ART UNIT	PAPER NUMBER
2876	

DATE MAILED: 07/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/691,409	SIEGEL, JAIME A	
	Examiner	Art Unit	
	Ahshik Kim	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05/03/03 (Response)* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-45* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-45* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Response

1. Receipt is acknowledged of the response filed on May 3, 2003. Claims 1-45 remain for examination.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-8, 10, 12-21, 23-28, 30-41, 43, and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kleiman (US 5,959,945) in view of Liu (US 5,953,005).

Kleiman teaches a content player jukebox IT, comprising in combination: a memory which stores content, possibly a magnetic disk CM3 (see figure 1); a playback credit bank 212 stored in the player; and a method of playing the content for consumption by a user, providing the credit bank has ample playback credit, and deducting credit when content is played, evidencing that there is circuitry present to perform such (see figure 7) The credit bank may be replenished by communication with smart card (col. 9, lines 3-6). The user may communicate with a service center, the center acting as a vendor, in that the smart card may be used to purchase credits via communication link, where the credits can then be transferred to the credit bank of the content player for usage (col. 14, lines 9-24). The link may be wireless or through

modem (Internet) access. The credits are transferred in the form of certificates, which are decrypted before storage (col. 14, lines 18-29). The service centers are stand-alone facilities, which would wholly include the realm of stand-alone transaction housings, terminals, kiosks, etc.

Kleiman fails to specifically teach or fairly suggest of charging a customer when the electronic content is repeatedly played.

Liu teaches a method and system for accessing electronic content (see abstract; col. 2, lines 18+), wherein provided authentication key expires after some period of time (col. 5, lines 33+) so that that the customer may not be able to enjoy the content repeatedly without paying.

In view of Liu's teaching, it would have been obvious to an ordinary skill in the art at the time the invention was made to further employ well-known method of charging a customer on pay-per-play basis to the teachings of Kleiman in order to accommodate customers who may prefer purchasing the content on one-time basis. Some customers may want to purchase contents temporarily, and some others buy them permanently and keep them for further enjoyment. Moreover, charging a customer on pay-per-view or pay-per-play is well known in the art, and widely used in various industries. Accordingly, incorporating various marketing alternative would have been obvious to one ordinary skill in the art to increase sales/revenue and expand customer base, and therefore, an obvious expedient.

Re claims 5-7, 20, 27, 34-41 and 43, Kleiman teaches that menus are provided on a display of content player IT, wherein what songs present in the player are shown. Being that the player is driven by credits accrued, it would have been obvious to one of ordinary skill in the art to have the available credits to be used in the player shown on such a screen, or rather the status of the credits within the player system. While it is not specifically taught, it would have be

known to include such as it would obviously provide user convenience and expedience in purchasing and using credits for content playback.

Kleiman also fails to teach both the content and credits to be stored in a storage medium. It would have been obvious to one of ordinary skill in the art to provide such a combination, as it would reduce the number of storage mediums necessary to fully operate the content player. The user could conveniently perform all operational tasks using one card (purchasing of credit, accrual of content, transferal of content, etc.), adding to customer satisfaction.

3. Claims 9, 11, 22, 29, 42, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kleiman as modified by Liu as applied to claim 1, 18, 25 and 34 above and further in view of Abecassis (US 6,192,340 B1, of record). The teachings of Kleiman as modified by Liu have been discussed above.

However, Kleiman/Liu fail to teach the content presented on a stick memory device and the content player as being portable.

Abecassis teaches a music player 100 that contains memory for storing playback music and credits, the credits deducted when listening to the music. Figure 2 shows that the device, now 200, may be portable. Column 6, lines 10+ discuss the use of different media to allow a user access to the player, those media including a cartridge, magnetic credit card, or Memory Stick.

In view of Abecassis' teaching, It would have been obvious to one of ordinary skill in the art to provide such a player as portable, as portable players, such as MP3 or CD players, are notoriously well-known to allow convenience for user to carry the player anywhere he/she chooses for enjoyment, rather than just be confined to enjoy such a device in his/her home or

office. Having a Memory Stick in place of a regular credit card or other storage card is a well-known, art-recognized equivalent in the industry. Stick type devices, such as Memory Sticks are known to be used in modern industry as they enable the user to carry a substantially large amount of data or information. Thus, such a replacement would have been obvious to one of ordinary skill in the art to incorporate.

Response to Arguments

4. The Examiner fully understands Applicant's comments and concern about previous Office Action being third non-final response. It is the Examiner's belief that the Office's compact prosecution policy is vigorously applied to the extent possible for the benefit of Applicants.

With respect to the merits of the application, Kleiman teaches a content player with payment means 212. Liu reference is cited to cure the deficiency of Klieman reference, use of credit-bank feature wherein the customer pays every time the content is played. Since Liu's key (or means enabling users to play the content) is provided with time limitation such that playing key is valid only for a time or number of plays (col. 5, lines 33+), it could be inferred that the users have to pay for additional plays. In view of that, users in fact are paying for the content in the manner known as "pay-per-view" or "pay-per-play". Accordingly, implementing Liu's feature, the users can't download content and repeatedly play the content, which the instant application claims. Once again, Liu is not cited for its authentication feature/algorithms.

Applicant's response has been carefully considered, however, in view of the above discussion, they are not persuasive. Therefore, the Examiner has made **this Office Action final**.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Russo (US 6,025,868) clearly discloses an apparatus and the method for playing content with pay-per-play.

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (703)305-5203 . The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax number directly to the Examiner is (703) 746-4782. The fax phone number for this Group is (703)308-7722, (703)308-7724, or (703)308-7382.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that

sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Ahshik Kim
Patent Examiner
Art Unit 2876
June 25, 2003

MICHAEL G. LEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800